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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Ellen Isaacs

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Samuel H. Dworetsky
AT&T CORPORATION
P.O. Box 4110
Middletown, NJ 07748-4110

EXAMINER

ELAHEE, MD S

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/834,089

Applicant(s)

ISAACS ET AL.

Examiner

Md S. Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-13 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-13 and 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/13/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed on 04/28/05. Claims 3-13 and 15-21 are pending. Claims 1, 2 and 14 have been cancelled.

Response to Arguments

2. Applicant's arguments with respect to claims 3-13 and 15-21 have been fully considered but they are not persuasive.

Regarding claim 3, the Applicant argues on page 8, lines 6, 7 that "In particular, the Office Action states that the "Distinctive Ringing" of the Epler reference reads on the "activity status message" of claim 1. Applicants traverse" and on page 8, lines 20 and 21 "The cited portion of Epler does not teach receiving an activity status message from a user as contemplated by the present invention". The examiner disagrees with this argument. Since "Distinctive Ringing" indicates the level of urgency of the communication from the caller, Epler's "Distinctive Ringing" reads on the claimed "activity status message" (see col.5, line 66-col.6, line 27). Thus the rejection of the claim in view of Mishra, Heinonen and Epler remain.

Regarding claim 9, the Applicant argues on page 13, lines 14, 15 that "This cited portion of Mishra does not teach that the ringing indication is "unique" to a particular user, as claimed in claim 9" and on page 13, lines 18-20 "However, nothing in Mishra teaches allowing a user to select a ringing indication or preventing more than one user from selecting the same ringing indication". The examiner disagrees with this argument. Examiner relied upon Mishra only for the teaching of "unique notification" [i.e., unique audible signature] (see page 3, paragraph 0044). Since, notification/ringing includes caller identification, call originator user ID, examiner

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interprets the notification/ringing to be unique notification/ringing. Thus the rejection of the claim in view of Heinonen and Mishra remain. Claims 16 and 21 are rejected for the same reasons as discussed above with respect to claim 9.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mishra (U.S. Pub. No. 2002/0110121) in view of Heinonen et al. (U.S. Patent No. 6,671,370) further in view of Epler et al. (U.S. Patent No. 6,026,156).

Regarding claim 3, Mishra teaches receiving an incoming message [i.e., message] from a caller [i.e., first user], the incoming message identifying at least one subscriber [i.e., message recipient] (page 3, paragraphs 0042-0044). (Note: since the incoming message is intended for a particular subscriber, it is inherent that the incoming message is identifying a particular subscriber)

Mishra further teaches providing the message to the at least one subscriber, wherein when the message is provided to the at least one subscriber, the caller's notification [i.e., sound ID] is played for the at least one subscriber upon delivery of the incoming message to the at least one subscriber, the notification is for identifying the caller to the at least one subscriber (page 3, paragraphs 0042, 0044).

However, Mishra does not specifically teach “the sound ID having been previously selected by the user”. Heinonen teaches the ringing indication [i.e., sound ID] having been previously selected by the user (abstract; col.3, lines 13-29, col.6, lines 17-27, col.10, lines 35-41). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mishra to allow the sound ID having been previously selected by the user as taught by Heinonen. The motivation for the modification is to have doing so in order to provide a caller option for making a selection of a particular ringing indication.

Mishra in view of Heinonen fails to teach “activity status message”. Epler teaches Distinctive Ringing (col.5, lines 61-67, col.6, lines 1-27; ‘Distinctive Ringing’ reads on the claim ‘activity status message’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mishra in view of Heinonen to allow activity status message as taught by Epler. The motivation for the modification is to have doing so in order to provide the contact information from where the incoming message being originated.

Regarding claim 4, Mishra in view of Heinonen fails to teach “the message provided to the at least one message recipient is an activity alert sound”. Epler teaches that the message provided to the at least one user is a Distinctive Ringing (col.5, lines 61-67, col.6, lines 1-21; ‘user’ reads on the claim ‘message recipient’ and ‘Distinctive Ringing’ reads on the claim ‘activity alert sound’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mishra in view of Heinonen to allow the message provided to the at least one message recipient is an activity alert sound as taught by Epler. The motivation for the modification is to have doing so in order to provide the contact information from where the incoming message being originated.

Regarding claim 5, Mishra teaches that the pre-announcement alerts the at least one callee that the first caller has become active on at least one client device (col.4, lines 52-62, col.6, lines 32-45, col.17, lines 9-30; 'pre-announcement' reads on the claim 'activity alert sound').

Regarding claim 8, Mishra teaches providing the message to the at least one subscriber comprises playing the first user's notification followed by the message, the message being an instant messaging communication (page 1, paragraph 0014, page 3, paragraphs 0042, 0044).

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mishra (U.S. Pub. No. 2002/0110121) in view of Heinonen et al. (U.S. Patent No: 6,671,370) further in view of Epler et al. (U.S. Patent No. 6,026,156) further in view of Walker et al. (U.S. Patent No. 6,397,184).

Regarding claim 6, Mishra in view of Heinonen further in view of Epler fails to teach "the sound ID is a snippet of notes". Walker teaches that the identification is an audio snippet (abstract; col.3, lines 34-47; 'identification' reads on the claim 'sound ID' and 'audio snippet' reads on the claim 'snippet of notes'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mishra in view of Heinonen further in view of Epler to allow the sound ID as a snippet of notes as taught by Walker. The motivation for the modification is to have doing so in order to provide the identification display.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mishra (U.S. Pub. No. 2002/0110121) in view of Heinonen et al. (U.S. Patent No. 6,671,370) further in view of Epler et al. (U.S. Patent No. 6,026,156) further in view of Meffert et al. (U.S. Pub. No. 2002/0059144).

Regarding claim 7, Mishra in view of Heinonen further in view of Epler fails to teach “the sound ID is at least a portion of a popular song”. Meffert teaches that the sound ID is at least a portion of a popular song (page 11, paragraph 0106). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mishra in view of Heinonen further in view of Epler to allow the sound ID being at least a portion of a popular song as taught by Meffert. The motivation for the modification is to have doing so in order to provide the attractive sound.

7. Claims 9, 11, 13 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heinonen et al. (U.S. Patent No. 6,671,370) in view of Mishra (U.S. Pub. No. 2002/0110121).

Regarding claim 9, Heinonen teaches receiving a plurality of ringing indications [i.e., audible signature] from a plurality of callers in the network, each user selecting a ringing indication to identify themselves to the other users in the network (abstract; fig.2, 3; col.3, lines 13-29).

Heinonen further teaches distributing communications between the plurality of users in the network, wherein each communication is accompanied by the unique call ringing indication [i.e., audible signature] of the user which initiated the communication so as to identify that user to the one or more users who are receiving the communication (fig.2, 3; col.3, lines 13-29, col.9, line 61-col.10, line 6).

However, Heinonen does not specifically teach a unique audible signature. Mishra teaches a unique notification [i.e., audible signature] (page 3, paragraph 0044). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Heinonen

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to allow a unique audible signature as taught by Mishra. The motivation for the modification is to have doing so in order to provide a notification to a called party for an incoming message from a particular caller. (Note; the notification includes caller identification, therefore, it is clear that the notification signal is unique for each caller)

Regarding claim 11, Heinonen teaches that the callers receiving the message [i.e., communication] is played the ringing indication of the user which initiated the communication followed by the playing of the actual communication (fig.2, 3; col.3, lines 13-29, col.9, lines 13-20; 'ringing indication' reads on the claim 'audible signature').

Regarding claim 13, Heinonen teaches providing a selection of ringing indications for selection by the plurality of users (abstract; fig.2, 3; col.3, lines 13-29).

Regarding claim 16 is rejected for the same reasons as discussed above with respect to claim 9. Furthermore, Heinonen teaches providing a selection facility for user selections of ringing indications, the ringing indications identifying the selecting user to other users in the communications network (abstract; fig.2, 3; col.3, lines 13-29, col.6, lines 17-27, col.9, line 61-col.10, line 6; 'ringing indications' reads on the claim 'audible sound identifiers').

Heinonen further teaches identifying the users to one another in the communication network, wherein identifying the users to one another comprises providing the users' selected ringing indications to one another in the course of communications between the users such that each user is identified to the other by the sound of their respective ringing indication (fig.2, 3; col.3, lines 13-29, col.9, line 61-col.10, line 6).

Regarding claim 17, Heinonen teaches that the selection facility comprises a plurality of ringing indications organized into categories (fig.2, 3; col.3, lines 13-29, col.5, line 64-col.6, line 8, col.9, line 61-col.10, line 6).

Regarding claim 18, Heinonen teaches that users are allowed to create their own ringing indications for inclusion in the selection facility (abstract; col.6, lines 17-27).

Regarding claim 19, Heinonen teaches that the ringing indications are not re-played for the receiving user inherently during repetitive communications between the users (fig.2, 3; col.3, lines 13-29, col.9, line 61-col.10, line 6).

Regarding claim 20, Heinonen teaches distributing the selected ringing indication corresponding to one user to the other users in the communications network (col.3, lines 13-29, col.9, line 61-col.10, line 6).

Regarding claim 21 is rejected for the same reasons as discussed above with respect to claim 9. Furthermore, Heinonen teaches that two or more of the plurality of users are inherently prevented from selecting the same ringing indication (fig.6; col.3, lines 13-29, col.10, lines 35-41).

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heinonen et al. (U.S. Patent No. 6,671,370) and in view of Mishra (U.S. Pub. No. 2002/0110121) and further in view of Meffert et al. (U.S. Pub. No. 2002/0059144).

Regarding claim 10, Heinonen teaches that the unique ringing indication is a portion of a song recognized by the subscribers as identifying the caller (page 2, paragraph 0025, page 12, paragraph 0148; 'ringing indication' reads on the claim 'audible signature', 'subscribers' reads on the claim 'receiving users' and 'caller' reads on the claim 'initiating user').

However, Heinonen in view of Mishra does not specifically teach “the unique audible signature is a portion of a song”. Meffert teaches that the unique audible signature is at least a portion of a popular song (page 11, paragraph 0106). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Heinonen in view of Mishra to allow the unique audible signature being at least a portion of a popular song as taught by Meffert. The motivation for the modification is to have doing so in order to provide the attractive sound.

9. Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heinonen et al. (U.S. Patent No. 6,671,370) and in view of Mishra (U.S. Pub. No. 2002/0110121) and further in view of Reformato et al. (U.S. Patent No. 6,229,880).

Regarding claim 12, Heinonen in view of Mishra fails to teach “activity status update”. Reformato teaches status information update (col.14, lines 17-29; ‘status information update’ reads on the claim ‘activity status update’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Heinonen in view of Mishra to allow activity status update as taught by Reformato. The motivation for the modification is to have doing so in order to provide the change in the status information.

Regarding claim 15, Heinonen in view of Mishra fails to teach “the audible signature is preceded by an activity signal, the activity signal based upon the activity level of the initiating user”. Reformato teaches that the identification is preceded by a status information, the status information based upon the activity level of the subscriber (col.14, lines 17-29; ‘identification’ reads on the claim ‘audible signature’, ‘status information’ reads on the claim ‘activity signal’ and ‘subscriber’ reads on the claim ‘initiating user’). Thus, it would have been obvious to one of

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ordinary skill in the art at the time the invention was made to modify Heinonen in view of Mishra to allow the audible signature being preceded by an activity signal, the activity signal based upon the activity level of the initiating user as taught by Reformato. The motivation for the modification is to have doing so in order to provide the status information of the message.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Burgess (U.S. Patent No. 6,359,970) teach Communications control method and apparatus.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.E.

MD SHAFIUL ALAM ELAHEE

July 15, 2005



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600